

REMARKS

In applicant's counsel's some 40 years of practice before the Patent Office, has he seen a more egregious case of a premature final rejection.

There are seven new objections and rejections contained in the final Office Action which is believed in part to be due to the fact that the Examiner issuing the penultimate Office Action of July 16, 2002, is a different Examiner than Examiner Blau, the author of the final action. It is not unusual for a newly assigned Examiner, especially one with the experience of Mr. Blau, to view the issues differently than a prior Examiner. However, this is not a justification for issuing a final action containing seven completely new objections and rejections.

The seven new objections and rejections are as follows:

1. "The specification is objected to under 37 CFR article 1.71 for not being written in an exact way to enable one skilled in the art to make or use the same. Specifically it is uncertain how to make the face wall interchangeable as stated on page 32 lines 1-5.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the interchangeable face walls in claims 10-12 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

3. Claims 1-9 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 4, and 20 are indefinite in that the claims states, 'said secondary planar wall ... solely supported on the perimeter wall, ... face wall being fixed adjacent the perimeter of the second wall'.

4. Claims 10-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is uncertain how the face walls are interchangeable in claims 10-12.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elmer in view of Shaw, Dill, and Werner.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elmer in view of Shaw, Dill and Werner as applied to claim 10 above, and further in view of McKeighen.

7. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lu in view of Elmer, Shaw and Werner."

The rejection of Claim 10, item 5 above, as being unpatentable over the Elmer, U.S. Patent No. 5,509,660, in view of the Shaw, U.S. Patent No. 5,362,047, the Dill, U.S. Patent No. 6,102,813, and the Werner, U.S. Patent No. 6,152,833, is completely off the wall. Not one of these references was cited in the history of this application prior to the final rejection.

The only previous rejection of Claim 10 is contained on page 10 of the Office Action of July 16, 2002:

"14. Claims 4-9, 10-12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lu in view of Allen '791(Allen) and either Chou or Kosmatka '547(Kosmatka)."

There is absolutely no relationship between this rejection of Claim 10 and the rejection set forth in paragraph 14 of the previous Office Action.

It is true that in the Amendment filed January 21, 2003; Claim 10 was amended to include the word "interchangeable", and this might be some justification for the new objections 1 and 2, and the amendment of Claims 1 and 4 to include the term "solely supported" in the Amendment filed on January 21, 2003, might provide some justification for the rejection in paragraph 3 above, as well as the new rejection in paragraph 4 above, but there simply is no justification for the rejection of Claims 10 and 11, as well as Claim 12(paragraph 6 above) over five newly cited references.

MPEP 706.07(a) provides: "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground or rejection that neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

These five new references certainly cannot be justified simply by the addition of the word "interchangeable".

In the Advisory Action dated June 17, 2003, the Examiner refused entry of applicant's Amendment of May 27, 2003, in its entirety even though the Examiner stated "newly proposed or amended claims 1-9 and 20 would be allowable". The attorney for the assignee is at a loss to determine why the Examiner did not enter the Amendment in part with respect to Claims 1 to 9 and 20 since it would obviously place this case in better form for appeal. The Examiner further states in the Advisory Action:

"The specification objection under 37 C.F.R. article 1.71 and the drawing objection under 37 CFR 1.83(a) have been overcome. The argument that Elmer is improper since Elmer does not suggest effecting a line of golf clubs is disagreed with. Elmer was not used to disclose a line of clubs but Werner has. Yet is believed that one skilled in the art would see it to be obvious to form a line of clubs just from Elmer since not all the players want the same characteristics and it would be obvious to present a line of clubs instead of kits so no assembly is required. Nevertheless Werner discloses a line of clubs to select from. The argument that Shaw is improper since Shaw does not disclose a line of clubs is disagreed with. Golfers selecting a different face material based on flexural modulus in order to suit the attributes of a specific golfer implies a line of clubs. However Shaw was not used for this. The argument that Lu is improper since it does not disclose a line of clubs is disagreed with.

Lu discloses clubs able to have different face materials. This implies a line of clubs. However Lu was not used for this."

Applicant assumes that these comments are applicable only to Claims 10, 11 and 12.

The Abstract has been objected to because it exceeds 25 lines of text and 150 words in length under the provisions of 37 CFR 1.52(b)(4), and a new Abstract is submitted herewith on a separate sheet with the proper length. For this reason, the objection to the Abstract is requested to be withdrawn.

The specification has been objected to under 37 CFR 1.71 "for not being written in an exact way to enable one skilled in the art to make or use the same" with the statement: "Specifically it is uncertain how to make the face wall interchangeable as stated on page 32 lines 1-5." This objection is respectfully traversed. Claim 10 has been amended to recite "a plurality of interchangeable during manufacture different modulus of elasticity face walls fixed to the body face wall receiving element."

Page 32 states: "Referring initially to Figs. 1 to 16, a club head 10 is illustrated according to the present invention that includes a standard body 11 and interchange-

able face walls 12. The body 11 may be formed in forward and rear pieces as described in my U.S. Patent No. 5,888,148."

As seen in Fig. 5, for example, the body 11, which is the lower portion shown indicated at 14 and 15 in Fig. 5, includes the secondary wall 26. The face wall 12a in Fig. 5 can be mounted in the recess 30 shown in Fig. 5, or any of the other varying face walls with different thicknesses shown in Figs. 7, 8, 9 and 10, can also be mounted in the same body 11. Obviously it is not exactly the same body, but what is referred to as being the same body 11 means that the multiple bodies 11 are made from the same tooling so that any one of the face walls in Figs. 7, 8, 9 and 10 can be mounted in a body 11 that is obviously different from the exact same body 11. That is, the face walls 12a, 12b, 12c and 12d can only be mounted in one body 11 and each requires a different body 11, but the bodies are identical because they are made from the same tool. The Examiner's confusion perhaps results from the interchangeability of the face walls is done during the manufacturing process, and once a face wall 12a, 12b, 12c and 12d is welded to a body 11, it

cannot thereafter be changed, and I'm sure the Examiner understands that, and it is respectfully requested that this objection be withdrawn.

The objection to the drawings for the same interchangeability reasons is also respectfully requested to be withdrawn.

Claims 1 to 9 and 20 have been rejected under 35 USC 112 as being indefinite because the Claims state: "said secondary planar wall --- solely supported on the perimeter wall, --- face wall being fixed adjacent the perimeter of the secondary wall". The Examiner then goes on to state that "It appears that the face wall also supports the secondary planar wall." The Examiner then goes on to provide a suggestion for overcoming this objection which has been made in the above Claims 1-9 and 20, so that this objection is respectfully requested to be withdrawn.

Claims 10 to 12 have been rejected under 35 USC 112, because: "It is uncertain how the face walls are interchangeable in claims 10-12". This confusion is believed explained in the above objection to the specification so that this rejection is now believed obviated.

Claim 10 has been rejected under 35 USC 103(a) as being unpatentable over the Elmer, U.S. Patent No. 5,509,660, in view of the Shaw, U.S. Patent No. 5,362,047; the Dill, U.S. Patent No. 6,102,813, and the Werner, U.S. Patent No. 6,152,833. Firstly, Claim 10 has been amended to recite "a plurality of interchangeable during manufacture different modulus of elasticity face walls fixed to the body face wall receiving element."

Firstly, it is not understood how a seven line Claim; i.e., Claim 10, requires the combination of some four references for anticipation. It seems that the multitude of references suggests only that Claim 10 and the Claims that depend therefrom are patentable.

The Examiner suggests that Elmer discloses a body having a plurality of "interchangeable(Col.6, Lns.1-4) different characteristic face walls in the form of different material(Col.5, Lns. 8-15) fixed to a wall receiving element in order to meet the requirements of different golfers by changing the striking characteristics(Col. 5, Lns. 56 through Col. 6, Lns. 12)." Elmer does suggest the possibility of providing different characteristic face walls with a common body 14. However, what he does not suggest is effecting that purpose "in a line of golf clubs". Further-

more, Elmer does not suggest having different modulus face walls 22 with the same body 14. And the Examiner admits that when he states: "Elmer lacks the striking characteristics being modulus of elasticity, a line of clubs, a perimeter wall, and a shaft." Then the Examiner looks to the Shaw patent, which is assigned to Dunlop Slazenger International, and is a patent cited and discussed in other applications assigned to the assignee of the present invention. But while Shaw describes having different face characteristics, he does so in a set of clubs and not a line of clubs, and this distinction has been discussed in detail in this case and in other cases filed by the assignee of the present invention. More specifically, Shaw, et al., provide, for example, the one, two and three irons, with one face characteristic; the four, five and six irons with another face characteristic, and the seven, eight and nine irons with a third set of characteristics. But this is not a line of clubs. A line of clubs consists of a line of drivers, for example, and nothing in Shaw, et al. suggest providing different characteristics in a line of drivers, for example, so that the Examiner's rejection must fall.

The Dill and Werner patents have been relied on to disclose minor features and will not be discussed further.

Claim 11 has been rejected under 35 USC 103(a) as being unpatentable over Elmer in view of Shaw, Dill and Werner as applied to claim 10 above, and further in view of the McKeighen, U.S. Patent No. Re.34,925, with the statement:

"Elmer lacks face walls having progressively increasing thickness in a line. McKeighen discloses a line of heads having progressively increasing thickness(Figs. 4-6, Col.3, Lns. 28-35). In view of the patent of McKeighen it would have been obvious to modify the line of clubs of Elmer to have face walls with different face thicknesses in order to utilize the advantages of different face wall thicknesses for players selecting a club to play with."

The deficiency in this rejection is that Elmer does not show a line of clubs and McKeighen does not show a line of clubs so that together they cannot suggest any construction of varying face modulus with face thickness in a line of clubs.

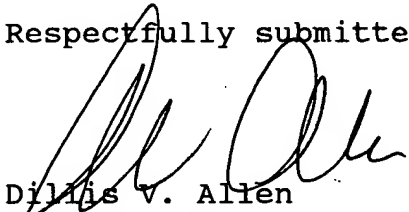
Claims 10-12 have been rejected under 35 USC 103(a) as being unpatentable over the Lu, U.S. Patent No. 5,499,814, in view of Elmer, Shaw and Werner.

Again, the deficiency in this rejection is the same as the ones discussed above because Lu does not suggest a line of clubs, Elmer does not suggest a line of clubs, so that when combining the two, it is unreasonable to assume

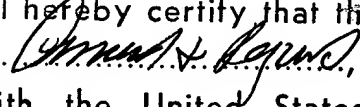
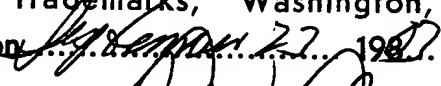
that any one skilled in the art would produce a line of clubs having various face thicknesses or face modulus of elasticity face walls.

As applicant has made a good faith effort to place this application in condition for allowance, reconsideration and issuance are respectfully requested.

Respectfully submitted,


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